

REMARKS/ARGUMENTS:

Reexamination and reconsideration of the application are requested.

The Applicants vigorously traverse the final rejection of claims 1-4 and 18-22 under 35 U.S.C. §102(e). The Applicants submit that the Office's reliance upon *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) and *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) is misplaced.

The Applicants do not disagree that a claim that merely recites a limitation regarding the manner in which a device is "intended to be employed" does not differentiate the claim from prior art if the art teaches all the "structural limitations" of the claim. Nor do the Applicants disagree that a claim directed to an apparatus must distinguish the apparatus from the prior art in terms of "structure rather than function." However, the Applicants submit that, as a matter of law, the claims do in fact distinguish the claimed apparatus over the prior art in terms of "structure" rather than function.

The disagreement with the Office appears to reside in the effect that features inherent to the controller have in distinguishing the claimed device over the prior art. The *Schreiber* case provides an example in point. *Schreiber* claimed an oil canister which identically constructed could be used to dispense popcorn. There was no structural distinction between the claimed device and the prior art device. The only distinction resided in the manner in which the device was used. By contrast, in Applicants' claimed invention, there is a structural distinction between the claimed device and the prior art device. That structural distinction resides in the manner in which the controller is designed (e.g., wired or programmed) to control the transducer.

The Applicants trust that in the *Response to Arguments* in the Office Action, the Office is not attempting to assert that machine program code is "function" and does not constitute a structural limitation. If this were correct, all of the software patents that have ever issued with claims directed to a computer readable media encoded with a program would be effectively worthless. They would not be structurally distinguishable from one another. Accordingly, the

Applicants trust that the Office does not dispute the fact that machine code can in fact qualify as a structural limitation.

With this background and based upon the assumption that the Office is not advocating to undo nearly 25 years of case law regarding the structural effect of program codes (see, for example, *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995)), the claims clearly distinguish Applicants' ultrasound device over that disclosed in Hadjicostis et al., U.S. Publication Application 2004/0254570 (hereinafter the "'570 Publication").

In the Applicants' response to the Office Action dated August 6, 2008, the Applicants have pointed out very clearly that the '570 Publication does not teach or suggest that an ultrasound medical treatment system includes a transducer and a controller and the controller is programmed to rotationally control the transducer to emit ultrasound to thermally ablate tissue at predetermined time intervals with the transducer located at different, spatially non-adjacent angular positions. To briefly summarize the Applicants' previous remarks, the '570 Publication illustrates an embodiment in Figs. 3 and 4 in which a plurality of transducers are positioned around the outside of a ring. These transducers are activated sequentially. The embodiment illustrated in Figs. 3 and 4 does not involve a single transducer which is activated at different spatially separated locations around the inside of a vessel such as the esophagus. Fig. 11 illustrates an embodiment in which a single transducer is used; however, there is no teaching in the '570 Publication that this transducer should be activated at different spatially separated locations.

Accordingly, there does not appear to be any question that the '570 Publication does not teach or suggest the Applicants' use of a single transducer in conjunction with a controller that activates the transducer at different predetermined spatially non-adjacent angular positions. The only issue is whether the description of the controller in the Applicants' independent claims defines structure or function.

In the *Reasons for Allowance*, the Office states that "there is no disclosure in any of the claims that [sic] stating that the controller is a programmable medium, nor that the controller is

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programmed. To make this statement, the Office cannot be reading the claims in light of the specification, nor is the Office construing the claims as they would be by a person skilled in the art. A person skilled in the art reading the Applicants' specification would clearly understand that the controller is an electrical device and, regardless of whether that device is programmable or hard wired, the distinction over the art is nevertheless a structural one (i.e., wires and/or code) and not merely a functional one. Apparently, there is no dispute that a hard wired controller would constitute structure as opposed to function. For the reasons discussed above in view of *In re Beauregard*, it is equally clear that a programmed, coded device must also be considered a structural distinction rather than a functional one.

For the reasons expressed above, the Applicants respectfully submit that the rejection under 35 U.S.C. §102(e) is improper, and it should be withdrawn. Favorable action on the merits are requested. In the event that the Examiner wishes to discuss any aspect of this response, please contact the undersigned at the telephone number indicated below. We hereby authorize the Commissioner under 37 C.F.R. § 1.136(a)(3) to treat any paper that is filed in this application which requires an extension of time as incorporating a request for such an extension. The Commissioner is authorized to charge any additional fees required or to credit any overpayment to Deposit Account No. 20-0809.

Respectfully submitted,

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